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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/907,899 | 07/19/2001 | Trond Gledje | 040042-002 | 9944 |

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ERICSSON INC.
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PLANO, TX 75024

EXAMINER

TODD, GREGORY G

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 2157 | |

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/907,899

Applicant(s)

GLEDJE, TROND

Examiner

Gregory G. Todd

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This is a second office action in response to applicant's amendment filed, 04 January 2005, of application filed, with the above serial number, on 19 July 2001 in which claims 1, 3, 5, 8-10, 12-13, and 15-17 have been amended. Claims 1-17 are therefore pending in the application.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Owensby (hereinafter "Owensby", 6,647,257).

Owensby teaches the invention as claimed including location based mobile advertising (see abstract).

As per Claim 1, Owensby teaches a system for providing advertisements to mobile stations comprising:

a service provider, wherein the service provider includes an information gateway and a service gateway (mobile switching center) (at least Fig. 1-2; col. 14, lines 3-38);

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a content provider for providing an advertisement to the service provider (Ad chooser server) (at least col. 14, lines 23-38, 55-62); and

a mobile station (wireless mobile terminal) (at least col. 14, lines 3-16; Fig. 1), wherein the service provider receives information associated with the mobile station from a mobile network, said information including mobile station capabilities (subscriber profile data associated with mobile terminal) (at least col. 15, lines 32-67; col. 2, lines 1-10; col. 4, lines 55-67; col. 11 line 51 - col. 12 line 4-38; col. 21, lines 58-67), and

wherein the mobile station receives the advertisement if the mobile station satisfies a predetermined condition associated with the advertisement, and the capabilities of the mobile station match at least one criterion associated with the advertisement (predetermined criteria of Ad target data) (at least col. 16, lines 3-21).

As per Claim 2. The system of claim 1, wherein the predetermined condition is setting up a call or entering a predetermined location (wireless mobile location being predetermined criteria) (at least col. 16, lines 3-21).

As per Claim 3. The system of claim 1, wherein the service gateway receives the information associated with the mobile station from the mobile network and wherein the information gateway provides the advertisement to the mobile station under the control of the service gateway (at least col. 16, lines 3-20; col. 14, lines 3-38).

As per Claim 4. The system of claim 1, wherein the content provider provides the advertisement to the service provider tagged with certain information (ad target data) (at least col. 15, lines 32-67; col. 16, lines 22-52).

As per Claim 5. The system of claim 4, wherein the content provider tags the advertisement with tags selected from the group consisting of:

information type;

zone/area related information;

information attributes;

information validity;

preferences; and

language keys (profile data including personal preference data for advertisers to target to a subscriber) (at least col. 15, lines 32-67).

As per Claim 6. The system of claim 1, wherein the service provider is a mobile Internet service provider (wireless Internet) (at least col. 11, lines 51-67).

As per Claim 7. The system of claim 1, wherein the service provider stores information related to the mobile station (data associated with subscriber collected upon initial registration) (at least col. 15, lines 32-67).

As per Claim 8. The system of claim 7, wherein the information related to the mobile station further comprises information selected from the group consisting of:

type of connection associated with the mobile station;

information type;

information profile;

language keys; and

whether the mobile station has activated receipt of advertisements (Subscriber profile data including personal preference data and demographic data) (at least col. 15, lines 32-67).

As per Claim 9. The system of claim 1, wherein the mobile station receives the advertisement only if subscriber specific information associated with the mobile station also matches at least one criterion associated with the advertisement (at least col. 15 line 32 - col. 16 line 20).

As per Claim 10, Owensby teaches a method for providing advertisements to a mobile station in a mobile network comprising the steps of:

soliciting, by a service provider, content providers (call management server choosing messages) (at least col. 13, lines 15-36);

providing an advertisement, by a content provider, to the service provider, wherein the advertisement includes information associated with the advertisement (ad target data) (at least col. 16, lines 22-50);

receiving by the service provider, information associated with the mobile station from a mobile network, said information including mobile station capabilities (at least col. 2, lines 1-10; col. 4, lines 55-67; col. 11 line 51 - col. 12 line 4-38; col. 21, lines 58-67);

soliciting, by the service provider, subscribers with mobile stations (subscriber wishing to receive ad-based subsidy) (at least col. 18, lines 58-67); and

sending the advertisement to the mobile station if the mobile station satisfies a predetermined condition associated with the advertisement, and the capabilities of the

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mobile station match the information associated with the advertisement (at least col. 16, lines 3-20).

As per Claim 12. The method of claim 10, wherein the service provider includes a service gateway and an information gateway (mobile switching center) (at least Fig. 1-2; col. 14, lines 3-38), and the method further comprises:

controlling, by the service gateway, the provision of the advertisement (predetermined criteria of Ad target data) (at least col. 16, lines 3-21).

Claims 11 and 13-17 do not add or define any additional limitations over claims 2 and 5-9 and therefore are rejected for similar reasons.

Response to Arguments

3. Applicant's arguments filed 04 January 2005 have been fully considered but they are not persuasive.

Applicants arguments are directed, substantially, toward the claims as amended to include having a service provider receiving information on a mobile station including capabilities of the mobile station. However, Owensby teaches that the mobile terminal must have, for example, a SIM or smart card, GPS capability, audio or video capability for an audio or video advertisement, or voice command capability, etc (at least col. 2, lines 1-10; col. 4, lines 55-67; col. 11 line 51 - col. 12 line 4-38; col. 21, lines 58-67). Thus, as these capabilities of the mobile station are inherent if not necessary in order to receive such a mobile advertisement, the subscriber would not receive such an

advertisement. In addition, Baker, Wynblatt and Nagendran further exemplify capabilities of mobile stations determining advertisements given to a mobile station.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Newly cited Baker, Wynblatt et al, and Nagendran, in addition to previously cited Bolduc et al, Hymel et al, Fan et al, Dowling et al, Kinnunen et al, Stewart, Hidary, Boyd, Host et al, Tuttlebee et al, Nihei, and Boyle et al are cited for disclosing pertinent information related to the claimed invention. Applicants are requested to consider the prior art reference for relevant teachings when responding to this office action.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory G. Todd whose telephone number is (571)272-4011. The examiner can normally be reached on Monday - Friday 9:00am-6:00pm w/ first Fridays off.

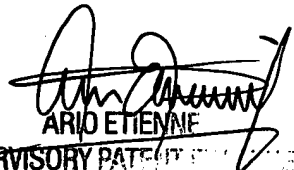
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory Todd 

Patent Examiner

Technology Center 2100


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